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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/574,720

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Sean O'Hara

25216-820

9790

29989

7590

09/03/2004

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EXAMINER

EISEN, ALEXANDER

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 09/03/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,720

Applicant(s)

O'HARA ET AL.

Examiner

Alexander Eisen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,10,12-20,22-26,28,30-32 and 44-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,10,12-20,22-26,28,30-32 and 44-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5-8, 10, 12-19, 28, 30-32 and 44-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Doval et al., (hereinafter Doval), reference of record.

With respect to claim 1 and 28 Doval discloses a method and a handheld computer comprising displaying a graphic representing computer functions on a touch-sensitive screen, the screen is coupled to a processor to detect and interpret contact with the screen; detecting a first sequence of contacts caused by user drawing a first drawing ; in response to detecting the first sequence, matching to and performing a particular action; detecting a second sequence caused by user drawing a second drawing; matching the second drawing to a second action of a set of functions and performing the second action, wherein the visual appearance of the graphic is the same when the user commences drawing the first drawing and the second drawing (FIGS. 2-4; col. 4, lines 4-20).

As to claims 5 and 44, as can be seen from FIG. 2 Doval discloses the sequence of contacts is smaller than the area of the graphic (i.e. user drawing such as circles or rectangles 161 are smaller than the graphic representing all area with the drawings).

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As to claims 6-8 and 45-47, Doval further discloses a drawing being an alphabet character, and the sequence can include a circle or a polygon (col. 4, lines 50-67).

As to claims 10 and 48, performing the particular action includes presenting a set of graphics to the user (col. 4, lines 29-39; col. 7, lines 11-18); and the graphics provides a plurality of user-selectable software (i.e. address book functions).

As to claims 12-19 Doval discloses that the connection between the screen and computer can be wired or wireless (col. 3; lines 3-14, lines 58-64) and connected to a network, such as Ethernet, modem (telephone line), etc.

As to claim 30-32, it is understood that once drawn on the screen virtual buttons (icons, generated by a computer in response to user drawing) stays displayed until erased (col. 6; lines 20-30).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 22-26 and 57-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doval in view of Eagle, references of record.

Doval discloses a method and a handheld computer comprising displaying a graphic representing computer functions on a touch-sensitive screen, the screen is coupled to a processor to detect and interpret contact with the screen; detecting a first sequence of contacts caused by user drawing a first drawing ; in response to detecting the first sequence, matching to and

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performing a particular action; detecting a second sequence caused by user drawing a second drawing; matching the second drawing to a second action of a set of functions and performing the second action, wherein the visual appearance of the graphic is the same when the user commences drawing the first drawing and the second drawing.

Doval does not disclose that the particular action includes performing an operating system function, such as deleting one or more software application from a memory of the handheld computer.

With respect to claims 20, 22-24 and 57-60 Eagle teaches a method and handheld computer, wherein an action performing an operation system function includes deleting a software application from RAM and permanent storage, such as programmable ROM, in order to upgrade the application software of the handheld computer and to load new software package to obviate the shortage of memory in such computers.

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to use the technique of Eagle in the device of Doval because it provides a sound method for upgrading the computer software, which otherwise would not be possible.

As to claims 25-26 and 61-62, the optical and magnetic computer-readable memory is well known in the art as non-volatile types of memory and therefore it would have been obvious to one of ordinary skill in the art at the time when the invention was made that programmable ROM in Eagle can of any known type of the memory, given that this would not have any significant effect on practice of the invention and would not cause any unexpected result.

As to claims 63-85, it will be well within the common knowledge of those of ordinary skill in the art that the application programs described in both Doval and Eagle represent an

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instruction set recorded on the computer-readable medium and executed sequentially in order to perform the methods of correspondent claims.

Response to Arguments

5. Applicant's arguments filed 09 January 2004 have been fully considered but they are not persuasive. Applicant argues that there is fundamental difference between the triggering action using a graphical system described in prior art and that of the invention. Claims of the invention require triggering an action in response to a drawing while prior art teaches that a drawing follow by a selection. Examiner respectfully disagrees. While Doval teaches triggering an action by a selection of a drawing, it also teaches that an action can be triggered by drawing itself (see col. 5, lines 3-6; col. 5, line 66 - col. 7, line 5 and claim 1 for examples). Therefore the rejection is maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (703) 305-4709. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Eisen
Primary Examiner
Art Unit 2674

1-Sep-04